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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,713	10/05/2001	Richard A. Fox	267/303	4498

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EXAMINER
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YOUNG, MICAH PAUL

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/972,713

Applicant(s)

FOX ET AL.

Examiner

Micah-Paul Young

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: A method step where the crystalline particles are coated. Method step (c) calls for *mixing the coated crystals with a carrier*, when no previous step describes a coating. These claims are rendered indefinite, though canceling or amending the claims can overcome this rejection.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al (USPN 5560917). Claims 1, 5 and 7 are drawn to an emulsion comprising particles coated with

methicone and a carrier. The carrier can be a cream, lotion wax or paste, and may additionally include vitamins and other extracts.

Cohen et al teaches a cosmetic composition for the skin comprising particles, coated with silicone surfactants such as methicone. The composition can be formulated into a cream, lotion or ointment and may also include vitamin C and E (Abstract; col. 5; lin. 21 – 27; col. 7, lin. 10 – 25). These disclosures, along with others, leave the claims anticipated.

6. Claims 1, 3 – 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Brieva et al (USPN 5800816). As previously discussed these claims are drawn to a particulate emulsion. The emulsion comprises particles that are either magnesium or aluminum oxide and measure between 40 and 2000 microns.

Brieva et al teaches a cosmetic composition comprising magnesium oxide particles measuring up to 100 microns, mixed with methicone. The formulation can be formulated into creams or lotions and contains additional surfactants (Abstract; col. 3, lin. 53 – 62; col. 4, lin. 22 – 37; col. 4, lin. 56 – 67). These disclosures, along with others, leave the claims anticipated.

Though neither of the references refers to their particles as crystals, their disclosures still anticipate the claims of the invention. Applicant uses the distinction of *crystalline* and *crystal* only to describe texture and particle size, not the state of the polymeric chain structure. With this taken into account, recitations of crystalline emulsion are not found to be patentably distinct from the prior art.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (USPN 4440745) in view of Brieva et al (USPN 5800816) and Cohen et al (USPN 5560917). Claims 1-5 are drawn to an emulsion comprising crystals coated with methicone and a carrier. Claims 2 recites that the methicone is coated to the crystals via a covalent bond, while claims 3 and 4 go on to describe the crystals in size and origin. Claim 5 recites appropriate carriers for the purposes of the invention. Claims 6 go on to recite that the ratio of the methicone to the crystals is 2:1; while 7 recites that the composition further comprises other excipients like vitamins, extracts perfumes and thickeners.

Schmidt et al discloses essential elements of claims 1-7, and 14-17. Schmidt et al teaches an abrasive cleaning composition comprising carriers, pharmaceutical agents, and various abrasives. The reference teaches among the constituents, possibilities include aluminum and

magnesium oxides, and optionally, depending upon the intended use, silicone oils, and natural or synthetic waxes. Schmidt teaches that the particles of the invention range in size from 10 – 1000 microns, but preferably up to 400 microns, though particle sizes above this, may be employed. The reference also teaches that the composition can be formulated as a cream, ointment, paste, or gel (Abstract; col. 2, lin. 63 – col. 3, lin. 8; col. 3, lin. 25 – 42; col. 2, lin. 60 – 67).

Though the reference discloses the general elements of the claimed invention, it is deficient. Schmidt is deficient in that it is silent to the type of bond between the constituents. This however, without supplemental showings of criticality from applicant cannot be given patentable weight. Furthermore, these bonds occur naturally between oxide molecules, and do not show the hand of the inventor, also not allowing patentable weight to be given. Another deficiency in the reference is that the particles are not referred to as crystalline. Applicant only applies this distinction to assign particle size and texture, not to distinguish between states of polymeric chain structure. With this distinction in mind, the reference provides particles, which fit into the scope of applicant lexicon.

Cohen et al and Brieva et al both teach cosmetic emulsions useful for the healthy maintenance of skin. As previously discussed, the references anticipate, and meet the limitations of the general claims of the invention. The only deficiencies in the claims are that they are silent to the ratio of methicone to particle though they do teach their general inclusion into the formulation. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

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Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparations of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971).

With this taken into account, one of ordinary skill in the art would have been motivated to combine the teachings Schmidt, Cohen and Brieva. There would have been motivation to follow the suggestion of Schmidt to combine the particles of the formulation with a silicone oil, surfactant or synthetic wax, like Cohen and Brieva, in order to increase lubrication for the particles throughout the formulation. There would have been motivation to combine the larger more abrasive particles of Schmidt with the formulations of either Cohen or Brieva in order to impart moisturizing, firmness and UV protective properties into the abrasive formulation of the Schmidt. It would have been obvious to one of ordinary skill in the art, at the time of the invention to combine the teachings as such with the expected result of abrasive composition with improved moisturizing, firmness and UV protective properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 703-308-7005.

The examiner can normally be reached on M-F 7:30am-4: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-746-7648 for regular communications and 703-308-1235 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-5014.

Micah-Paul Young  
Examiner  
Art Unit 1615

mpy  
May 29, 2002

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600